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PTO/SB/33 (09-08)  
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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

FLEECE.001RC2

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on November 12, 2008

Signature

Typed or printed name Robert F. Gazdzinski

Application Number

10/692,835

Filed

10/23/2003

First Named Inventor

Martine Fennelly

Art Unit

3643

Examiner

Nguyen, Son T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 39,990

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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11/12/2008

Date

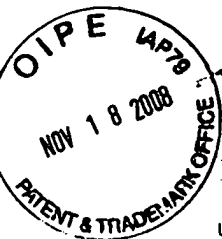
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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portion of the saddle would be raised. Accordingly, Applicant submits that Applicant's specification as filed clearly contemplated embodiments in which limitations that recite "*partly off only said withers*", "*elevating only a front portion*", "*prop up only a front portion*", and "*to raise only a frontal portion*" are clearly supported. Accordingly, Applicant respectfully submits that the Examiner has committed clear error in issuing a rejection of Applicant's claims under 35 U.S.C. §112, first paragraph.

**Claim 92** – Per page 3 of the Office Action, Claim 92 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states that "*a plurality of densities is not described in the specification.*" Applicant respectfully submits that this assertion is clear error, in that use of a plurality of densities (both intra-pad or within the same pad, and inter-pad or across two or more different pads) is explicitly supported in the specification as filed:

"In one exemplary embodiment, the component comprises one of a variety of pre-configured saddle pad inserts having different properties (e.g., thickness, density, shape, taper, etc.) suited for different applications." Page 16, lines 11-13 {Emphasis added}

"Other embodiments have specially configured shape, density, and thickness profiles to provide users with a substantially customized fit to their particular animal and saddle." Page 16, lines 18-19 {Emphasis added }

"Furthermore it will be appreciated that the density of the foam may be adjusted and or varied as a function of location on each pad (or across different ones of individual pads), ..." Page 27, lines 1-3 {Emphasis added}

See also Claim 55 as originally filed with the specification:

"55. The pad element of Claim 53, wherein said pad element has a plurality of densities associated therewith in its uncompressed state." {Emphasis added}

## II. CLEAR ERROR ON EXAMINER'S §102 REJECTIONS IN LIGHT OF VASKO ET AL. (U.S. PATENT NO. 4,683,709, HEREINAFTER "VASKO")

**Claims 70 and 103** – Per page 3 of the Office Action, Claims 70 and 103 each stand rejected under 35 U.S.C. §102 as being anticipated by Vasko. Firstly, both Claims 70 and 103 recite disposing pads "*such that said saddle and saddle pad apparatus is raised at least partly off of only said withers region of said subject.*" Applicant respectfully submits that the Examiner appears to have completely ignored Applicant's use of the word "*only*", and instead alleges Vasko teaches raising at least partly off of the withers region generally. Accordingly, even assuming *arguendo* that the Examiner's statement is correct, the Examiner has committed clear error by ignoring limitations present in Applicant's claims. Further, Applicant notes that Vasko does not mention the withers region of a horse anywhere within its disclosure and accordingly,

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Applicant submits that Vasko doesn't recognize nor teach the problem addressed by Applicant's claimed invention.

However, while not specifically addressing Applicant's limitation, the Examiner does assert that Vasko teaches a variety of different configurations that can be used for the pads and pockets and that those pads can be removed as desired. Applicant respectfully disagrees. The passage the Examiner refers to is at Col. 5, lines 3 – 8 of Vasko which states:

*"Finally, it will be appreciated that the pockets and inserts may be of such configuration that one embodiment of the invention may comprise a single pocket and a single insert or another embodiment may comprise a single pocket and two separate inserts and yet another embodiment may comprise multiple pockets and inserts."*

Nowhere in this cited passage does Vasko contemplate embodiments in which pads can be removed as desired as alleged by the Examiner. Rather, Vasko merely contemplates embodiments which employ pads in various numbers including in numbers which outnumber the number of pockets. No teaching or suggestion of selective removal of pads (i.e., use of only a subset) is disclosed by Vasko.

Secondly, Claim 70 sets forth *"first and second pads straddle said spinal column and are sufficiently distant therefrom so that said saddle pad apparatus does not impede movement of the spinal column"*. Claim 103 sets forth a similar limitation that emphasizes not impeding movement of the spinal column. The Examiner essentially argues that this is taught by Vasko implicitly at Fig. 2, i.e., the pads of Vasko will allegedly push the centerline 26 off of the spinal column somewhat. However, Applicant submits that there is no discussion in Vasko which would suggest that this is actually the case (i.e., that Vasko teaches pushing the centerline 26 off of the spinal column somewhat). Vasko actually appears to teach quite the opposite at, for example, Col. 3, lines 21 – 31 of Vasko which states:

*"The pad is then aligned upon the horse's back such that the centerline stitching 26 is adjacent and parallel to the horse's spinal vertebrae. The pockets are located immediately adjacent to and on each side of the centerline 26 so as to hold the inserts 36 and 38 parallel to and in immediate proximity to the horse's spine. This allows the load of the rider and the accompanying shock or energy transfers to be evenly distributed along the horse's back avoiding any undue abrasion of the thoracic spinal vertebrae."* {Emphasis added}

Each of the above emphasized portions of Vasko suggest that Vasko did not contemplate pushing the centerline off of the spinal vertebrae of a horse as suggested by the Examiner, because Vasko emphasizes holding the inserts in *"immediate proximity"* to the horse's spine, and ensuring that the pockets are *"immediately adjacent"* to the centerline 26. Further, Vasko clearly states that the pad is intended to evenly distribute the load of the rider along the horse's back avoiding any *"undue abrasion"* of the thoracic spinal vertebrae. In common parlance, the term *"undue"*

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means exceeding what is appropriate, excessive<sup>1</sup>. This clearly implies some “*abrasion*” is allowable so long as it is not “*undue*”, which is accomplished (as stated by Vasko) by evenly distributing the load of the rider along the horse’s back. Applicant submits that there simply is no support for the Examiner’s contention. In fact, much of the discussion in Vasko *pointedly teaches* away from the Examiner’s interpretation. Applicant therefore respectfully submits that the Examiner has committed clear error in the analysis of Claims 70 and 103 by: (1) ignoring limitations present in Applicant’s claims; and (2) mischaracterizing the teachings of Vasko as it applies to Applicant’s claims.

**Claim 91** – Per page 3 of the Office Action, Claim 91 stands rejected under 35 U.S.C. §102 as being anticipated by Vasko. Applicant respectfully submits that the Examiner has committed clear error in this rejection. Specifically, Applicant submits that Vasko fails to teach or suggest: “*wherein said pad element is particularly shaped to accommodate and fit substantially within a particular withers region recess on the anatomy of an animal on which said pad element and saddle pad is utilized.*” The Examiner appears to state that the functional recitation of “*particularly shaped to accommodate and fit substantially within*” constitutes an intended function to which the pads of Vasko are capable of performing. Applicant respectfully disagrees.

In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “*whereby*” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” See also MPEP § 2111.04. Here, Applicant has positively set forth a structure that is not optional and that is material to patentability; i.e., a pad element particularly shaped to fit substantially within a particular withers region recess. Accordingly, Applicant submits that the Examiner has committed clear error by ignoring the patentable weight and language of Claim 91. Further, Applicant submits that Vasko fails to teach such a limitation as claimed, teaching literally nothing of the “withers” region at all, let alone the claimed limitations.

**Claim 92** – Per page 3 of the Office Action, Claim 92 stands rejected under 35 U.S.C. §102 as being anticipated by Vasko. Applicant respectfully submits that the Examiner has committed clear error. Specifically, Applicant submits that Vasko fails to teach or suggest a “*pad element [that] has a plurality of densities associated therewith in its uncompressed state.*” The Examiner argues this is taught by Vasko because the density of the pad inherently changes as it is compressed (or alternatively uncompressed). Applicant submits that such an interpretation ignores Applicant’s explicit recitation of the term “*uncompressed state*” in Claim 92, and accordingly constitutes clear error.

**Claim 93** – Per page 3 of the Office Action, Claim 93 stands rejected under 35 U.S.C. §102 as being anticipated by Vasko. Applicant respectfully submits that the Examiner has committed clear error. Specifically, Applicant submits that Vasko fails to teach or suggest “*wherein said plurality of densities are substantially stratified with respect to the width dimension of said element.*” The Examiner alleges that this is taught by Vasko at Figs. 5 – 7.

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<sup>1</sup> <http://dictionary.reference.com/browse/undue>, last viewed November 7, 2008.

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However, it appears that the Examiner is interpreting plurality of densities to mean *plurality of thicknesses*. Applicant submits that such an interpretation is inapposite to both (i) the teachings of Applicant's specification as filed, and (ii) the plain meaning of the term (density is not the same as thickness) and accordingly, constitutes a clearly erroneous rejection.

**III. CLEAR ERROR ON EXAMINER'S OBVIOUSNESS REJECTIONS OVER VASKO IN VIEW OF WOODS (U.S. PATENT NO. 5,802,709, HEREINAFTER "WOODS")**

**Claim 87** – Per page 6 of the Office Action, Claim 87 stands rejected as being unpatentable over Vasko in view of Woods. Applicant respectfully submits that the Examiner has committed clear error in rejecting Applicant's Claim 87 invention. Specifically, the Examiner alleges that Vasko teaches:

*"...pad elements are disposed and configured to substantially fill respective ones of gaps that occur on the anatomy of said high-withered equine in its withers region, thereby substantially relieving this region from excessive pressure and contact with said saddle in a gullet channel"*

Applicant respectfully submits that Vasko does not teach or suggest anything remotely resembling Applicant's claimed language. Vasko (i) does not once mention or otherwise allude to the withers region of an equine, nor does Vasko concern itself with (ii) distinguishing the withers region from any other region of the equine anatomy (an essential distinguishing feature of Applicant's invention of Claim 87), or (iii) structure that relieves the withers region from pressure. Nor does Vasko discuss relieving the withers region from contact with the saddle in a gullet channel. The Examiner has failed to provide any citation to where such limitations might be taught by Vasko and its Applicant's belief that Vasko does not teach or suggest anything of the sort. Applicant submits that Woods is equally devoid of any such teaching. Accordingly, Applicant submits that the Examiner has committed clear error by failing to address each and every limitation present in Applicant's claims.

**Claim 89** – Per page 6 of the Office Action, Claim 89 stands rejected as being unpatentable over Vasko in view of Woods. Applicant respectfully submits that the Examiner has committed clear error in rejecting Applicant's Claim 89 invention. Specifically, the Examiner alleges that Vasko teaches:

*"...at least one peripheral ridge ... cooperating with an edge of said saddle to substantially frustrate relative motion between said saddle pad and said saddle in at least one direction during riding"*

Applicant submits that Vasko does not teach such a structure as claimed, and that the Examiner fails to specifically address this limitation within the Office Action. Applicant submits that Woods is equally devoid of any such teaching. Accordingly, Applicant submits that the Examiner has committed clear error by failing to demonstrate that Vasko or Woods teaches or suggests each and every element present within Applicant's Claim 89 invention.